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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,575	'06/28/2001	Makoto Yamashita	04329.2588	2542

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WASHINGTON, DC 20005

EXAMINER

ELAHEE, MD S

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/892,575

Applicant(s)

YAMASHITA, MAKOTO

Examiner

Md S Elahee

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04 & 05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

**DETAILED ACTION**

***Restriction Requirement***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:  
  
Group I. Claims 1-3, 8, 9, 11, 12, 14-16, 18, drawn to Special service, classified in Class 455, subclass 414.1.  
  
Group II. Claim 4-7, 10, 13, 17, 19, drawn to Call routing and Specific paging technique, classified in Class 455, subclasses 445, 458.  
  
Group III. Claim 20-27, drawn to Radiotelephone system.
2. Inventions Group I, Group II and Group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In this instant case, invention Group I has separate utility such as for use in a response message reproducing method used in a wireless communication system including a portable unit and a personal computer for communicating with each other by radio, whereas, invention Group II has separate utility such as for use in a response message recording method used in a wireless communication system including a portable unit and a personal computer for communicating with each other by radio, whereas, invention Group III has separate utility such as for use in a communication system including a first portable unit and a second portable unit for communicating each other. See M.P.E.P. § 806.05(d).
3. Because these inventions are distinct for the reason given above and the search required for Group I is not required for Group II as well as Group III, restriction for examination purposes as indicated proper.

4. During a telephone conversation with Richard Burgujian on 03/18/04 a provisional election was made without traverse to prosecute the invention of Group III, claims 20-27. Affirmation of this election must be made by applicant in responding to this Office action. Claims 1-19 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. **Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).**

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 20-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Tabeta (U. S. Patent No. 6,085,079).

Regarding claims 20, 23 and 25-27, Tabeta teaches that a communication system including a mobile terminal 107 (i.e., first portable unit) and a VM unit 111 (i.e., second

portable unit) for communicating with the first portable unit, wherein the mobile terminal 107 comprises a receiver 202 (i.e., first communication unit) communicating with subscriber's line (i.e., another unit) via a public line of telecommunication (abstract; fig.1, fig.2; col.3, lines 41-50, 56-58, col.5, lines 46-51).

Tabeta further teaches a transmitter 205 (i.e., second communication unit) communicating with the VM unit 111 (i.e., second portable unit) (fig.1, fig.2; col.6, lines 9, 10).

Tabeta further teaches a CPU 206 (i.e., first communication control unit), when the receiver 202 receives a call from subscriber's line, causing the receiver 202 to communicate with the VM unit 111 and transmit acquired information by communication to subscriber's line (fig.1, fig.2; col.3, lines 41-50, 56-58, col.5, lines 46-67, col.6, lines 1-16).

Tabeta further teaches that the VM unit 111 (i.e., second portable unit) comprises an antenna 301 (i.e., third communication unit) communicating with the transmitter 205 (fig.1-fig.3; col.5, lines 46-67, col.6, lines 1-16, 51-53).

Tabeta further teaches a data memory 311 (i.e., storage device) storing a voice data (i.e., response message) (fig.3; col.7, lines 24, 25).

Tabeta further teaches a CPU 306 (i.e., second communication control unit) causing the antenna 301 to transmit the response message stored in the data memory 311 to the transmitter 205 according to a request of the transmitter 205 of the mobile terminal 107 (i.e., first portable unit) (fig.1-fig.3, fig.42, step s4108; col.5, lines 46-67, col.6, lines 1-16, col.37, lines 9-31).

Regarding claim 21, Tabeta teaches communication between the first portable unit and the second portable unit is performed by radio (fig.1; col.6, lines 51-53).

Regarding claims 22 and 24, Tabeta teaches that a communication system including a mobile terminal 107 (i.e., first portable unit) and a VM unit 111 (i.e., second portable unit) for communicating with the first portable unit, wherein the mobile terminal 107 comprises a receiver 202 (i.e., first receiving unit) receiving a message from subscriber's line (i.e., another unit) (fig.1-fig.3; col.3, lines 41-50, col.4, lines 38-50).

Tabeta further teaches a transmitter 205 (i.e., transmitting unit) transmitting the message received by receiver 202 to the VM unit 111 (i.e., second portable unit) (fig.1, fig.2; col.6, lines 9, 10).

Tabeta further teaches that the VM unit 111 (i.e., second portable unit) comprises an antenna 301 (i.e., second receiving unit) receiving the message transmitted from the VM unit 111 (fig.1-fig.3; col.5, lines 46-67, col.6, lines 1-16, 51-53).

Tabeta further teaches a data memory 311 (i.e., storing device) storing a voice data (i.e., response message) received by the antenna 301 (abstract; fig.3; col.4, lines 38-48, col.7, lines 24, 25, 48-62, col.8, lines 46-53).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ishigami (U. S. Patent No. 6,085,079) teach Data transfer method.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alam Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

Art Unit: 2645

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

M.E.

MD SHAFIUL ALAM ELAHEE

April 12, 2004

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to be 'Fan Tsang', written in a cursive style.